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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
HUH, BENJAMIN	

ART UNIT	PAPER NUMBER
3767	

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	**Application No.** 10/685,690	**Applicant(s)** COVER ET AL.	
	Examiner Benjamin Huh	**Art Unit** 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 43-72* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 & 43-72* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *2/9/04* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *10/14/03 & 8/3/04*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6652488B1. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-72 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-24, 36, 42 of U.S. Patent No. 6652488. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the features are disclosed in the patented claims but have subtle differences in name such as member being a limited suction member or a first flow control being a first flow control means.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Zinnanti (US Patent No. 5348555). The Zinnanti reference discloses a surgical suction irrigation handpiece in figures 1-9 comprising a rounded housing shell 12; an elongate conduit 30 integrally fixed to the shell 12; at least one fluid tube extending away from the shell seen in figures 1, 4, 7, & 9; manual valve actuators (98,100) facing out from and spaced along a wall adjacent the conduit 30 and including a first valve actuator 98 and a second manual valve actuator 100, also see col. 2 line 46 – col. 3 line 68.

Claims 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Zinnanti (US Patent No. 5348555). The Zinnanti reference discloses a surgical fluid flow controlling handpiece in figures 1-9 comprising a housing 12 having a fluid flow passage 30 with a surgical site opposable port; an irrigation liquid connection 66 to the housing; an irrigation valve 78 having an open position and a further position of reduced communication of the irrigation connection to the fluid flow passage; a suction connection 68 to the housing; a reciprocating suction valve 80 having an open position; a limited suction member 96 being a rotating valve associated with the suction valve 80 and having a position corresponding to a limited suction flow between the suction connection and the fluid flow passage wherein the suction member is rotated up or down to allow for limited suction; a surgical site engagable tip 38 coupled to the port.

Claims 52-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Zinnanti (US Patent No 5348555). The Zinnanti reference discloses a surgical fluid flow controlling handpiece in figures 1-9 having a range of relatively low flow rates and a relatively high flow rate comprising a housing 12 having a fluid flow passage 30 therethrough; a first flow control 96 on said housing and operatively associated with said passage, said first flow control 96 can have a range of positions corresponding respectively to a range of relatively low flow rates through said fluid flow passage wherein the control 96 is rotated to allow a minimum amount of reciprocating movement of the valve to minimize the flow through the passage; a second flow control 100 on said housing and operatively associated with said passage and said first flow control 96, said second flow control having a position and said first flow control having a given position in its said range of positions, which said first flow control given position and said second flow control position together correspond to a relatively high flow rate through said passage, position seen as when control 96 is rotated all the way to the top to be adjacent control 100 to allow maximum flow through the passage, also see col. 5 lines 30-40.

With regards to claim 53, in which the second flow control comprises a valve member 78 axially displaceable in the housing and located across the fluid flow passage having a transverse opening and able to provide a relatively high flow rate when the opening is fully lined up with passage 30, the axially displaceable valve member having a seal, seen as the walls surrounding valve member 78, adjacent the transverse opening; the first flow control comprising a rotatable member 96 having a range of positions with respect to the housing and valve member, the rotatable member causing a window, seen as the passage produced by the opening of the valve not fully being in line with passage 30 due to the location of rotatable member 96, interposed between the seal and the fluid flow passage 30 at positions in the range and allowing for relatively low flow rates due to the smaller areas in the passage.

Claims 58-64 & 69-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Zinnanti (US Patent No. 5348555). The Zinnanti reference discloses a surgical suction irrigation handpiece comprising a housing 12 having a suction port 68, an irrigation liquid inlet port 66, and a third port 36 opposable to a surgical site; and irrigation liquid flow control assembly 98 on the housing; a suction flow control assembly (96,100) with a reciprocating valve, a first suction valve actuator, 100 and rotating valve element, second suction valve actuator, 96 on the housing both located in one suction flow path; and a first relatively high rate suction flow path between said suction port and third port when the rotating element 96 is placed in the highest position adjacent 100 and the reciprocating button 100 is pushed in all the way, and a second relatively low rate, suction flow path between the suction port and third port when the element 96 is rotated down the threads away from element 100 to minimize the amount of flow through the valve to cause a low suction rate.

With regards to claim 62, wherein the first relatively high rate includes a substantially straight portion see figure 9, and wherein the second relatively low rate includes a curved portion offset from the straight portion when flow path is not fully lined up with the passage 30 in a straight manner since element 96 is not fully adjacent element 100 which would cause the flow path to be curved and slow the rate.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 46-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zinnanti (US Patent No. 5348555) as applied to claim 43 in further view of Lienen et al (US Patent No. 6029702). The Zinnanti reference also discloses the suction valve 80 including a valve barrel in the fluid flow passage and an axially displaceable valve member 100 having a substantially closed position when not depressed. Now, even though the Zinnanti reference does not explicitly disclose the use of a leak control sleeve rotatable in the valve barrel with a seal member on the valve member attention is directed to Lienen et al. The Lienen et al reference teaches the use of a leak control sleeve 24 rotatable in the valve barrel, able to block flow see figure 4, the sleeve having a peripheral wall and a window through parts in figures 1-5 & 8-12 as well as a seal member 30, a spool having diametrically opposite axially extending ribs, on the valve member which shares a common radial plane with the valve barrel, and which can create windows to create narrow to wider flow paths around the member 30. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to incorporate the sleeve and seal member of Lienen into the device of Zinnanti in order to provide a greater range of control of the flow through the suction passage.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zinnanti (US Patent No. 5348555) in view of Saravia et al (US Patent No. 5484402). Even though the Zinnanti reference does not explicitly disclose the use of open switch contacts on the housing and operatively associated with the valve member as well as a fluid pump unit connected to the fluid supply connection with energized and deenergized conditions attention is directed to Saravia. The Saravia reference teaches the use of an electric circuit including open switch contacts with an energy source and a fluid pump unit, see col. 5 line 66 – col. 8 line 20, col. 11 lines 23-60, figures 1 & 2, & claims 6 & 17, therefore it would be obvious to one of ordinary skill in the art at the time of the invention to modify the device of Zinnanti with the components of Saravia in order to provide a means for energizing a pump to produce a controlled high rate of flow for the irrigation process.

Claims 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zinnanti (US Patent No. 5348555) in view of Saravia et al (US Patent No. 5484402). The Zinnanti reference discloses a surgical suction irrigation handpiece comprising a housing 12 comprising a suction port 68 connectable to a suction source, an irrigation liquid inlet port 66, and a third port 36 opposable to a surgical site; an irrigation liquid flow control assembly 98 on the housing; a suction flow control assembly (96,100) seen in figure 9 on the handpiece including a hand engagable reciprocating member 100 and a hand engagable rotating member 96 adjacent said hand engagable reciprocating member; in which the reciprocating valve element can have a closed position when the member is in the up position and not allowing any flow and wherein the rotating valve element can have an open position defining a suction flow bypass around the reciprocating valve element, when it is seen that the reciprocating valve does not have to be closed simultaneously when the rotating valve is open; a suction flow path seen as part of path 30 between said third port and suction port, also see col. 3 lines 29-68.

Even though the Zinnanti reference does not explicitly disclose a remote irrigation liquid pump unit attention is directed to Saravia et al. The Saravia et al reference discloses the use of a irrigation liquid pump, see claims 1, 4, 6, 8, & 14, therefore it would be obvious to one of ordinary skill in the art at the time of the invention to incorporate the irrigation liquid pump of Saravia into the device of Zinnanti in order to produce a desired flow rate for the irrigation process.

Claims 65-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zinnanti (US Patent No. 5348555) in view of Saravia et al (US Patent No. 5484402). The Zinnanti reference discloses a surgical suction irrigation apparatus in figures 1-9 comprising a handpiece, a suction valve (96,100) between a suction source connection 68 and a surgical site connectable port 36; an irrigation liquid valve 78 on the handpiece. Now even though the Zinnanti reference does not explicitly disclose a pump unit or an impeller connected to the irrigation liquid valve attention is directed to Saravia et al. The Saravia et al reference teaches the use of a pump unit utilizing a pressure adding impeller having a deenergized condition and an energized condition to produce an higher than gravity pressure as well as a switch, an electric current flow path, and a signal path between the switch and pump unit, see col. 5 line 66 – col. 8 line 20, col. 11 lines 23-60, figures 1 & 2, & claims 6 & 17. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the device of Zinnanti with the device of Saravia in order to provide a controlled irrigation flow rate with an ability to increase the flow rate as desired.

With regards to claim 68, even though the Zinnanti reference does not explicitly disclose the irrigation liquid inlet being formed as an upstanding hollow spike so that it can engage a irrigation liquid supply bag attention is directed to Saravia. The Saravia reference discloses the use of an irrigation liquid inlet being from as an upstanding hollow spike, therefore it would be obvious to one of ordinary skill in the art at the time of the invention to incorporate the in order to provide a means for engaging a irrigation liquid supply bag, also see claims 14-16.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Huh whose telephone number is 571-272-8208. The examiner can normally be reached on M-F: 9:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BHH

KEVIN SIRMONS
PRIMARY EXAMINER

Kevin C. Sirmons